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EXAMINER	
GILBERT, WILLIAM V	

ART UNIT	PAPER NUMBER
3635	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/817,149	Applicant(s) PRINGLE ET AL	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 5,13,26 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12,14-25 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/9/04, 7/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a First Action on the Merits. Claims 1-34 are pending.

Election/Restrictions

1. Applicant's election without traverse of Claims 1-4, 6-12, 14-25 and 27-44 in the reply filed on 09 August 2007 is acknowledged. Claims 5, 13, 26 and 34 are withdrawn.

Claim Objections

2. Claims 1, 16 and 27 are objected to because of the following informalities:

Claim 1: the Applicant claims only the apparatus, "a backsplash" but later claims the backsplash in combination with a work surface (line 5) and a first surface (line 5). The phrase "for protecting a first surface adjacent a work surface substantially perpendicular to the first surface" (preamble) is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The same applies to Claim 16.

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Claim 27: the Applicant claims a method but does not positively claim "a backsplash", "a first surface" or "a work surface" (preamble). The Examiner suggests using language in the body of the claim to positively claim these features (e.g. "providing a backsplash", "providing a first surface", etc.)

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 14 and 15 are rejected under 35

U.S.C. 102(b) as being anticipated by Han (U.S. Patent No. 5,816,005).

Claim 1: Han discloses a backsplash comprising a layer of tiles (5) having a front surface exposed and resistant to byproducts of work, the layer of tiles are integral and a mount

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(Fig. 2c: the screws) to releasably couple (by removing the screws) the backsplash to the first surface (Fig. 2c: portion where screw terminates) in at least one location between the backsplash and the first surface, the mount retains the layer of tiles in a perpendicular relationship with respect to a work surface (Abstract: the counter), when the backsplash is in the mounted position on the first surface. The phrase "for protecting a first surface adjacent a work surface substantially perpendicular to the first surface" (preamble) is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 2: a support (3) where the tiles are mounted

Claim 3: a frame (1) to receive the support.

Claim 4: the support is a flat panel.

Claim 6: the frame is shaped to receive the layer of tiles

Claim 14: tiles are resistant to fluid.

Claim 15: the phrase "dimensioned to be received between the work surface and a range hood..." is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 7-12, 16-25, 27-30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Breslow (U.S. Patent No. 3,672,622).

Claim 7: Han discloses the claimed invention except for the limitations of the first and second mounts as claimed, where the first mount is coupled to the second mount to removably couple the backslash to the first surface. Breslow discloses an apparatus with first and second mounts (Fig. 2: 10, 11) that are removably coupled. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mount with the panel system in Han because the mount would permit removal of the panel in Han for ease of replacement if damaged while also securing it properly to a surface.

Claim 8: Han in view of Breslow shows the mounts are shaped to maintain a part of the backslash against the first surface.

Claim 9: Han in view of Breslow discloses the mounts are releasably coupled by at least one projection (Breslow: 3b) on the first mount received within an aperture (between 3 and 2) of the second mount.

Claims 10 and 12: the first and second mounts (Breslow: 10, 11) are shaped to draw the backslash to the first surface as the mounts are coupled together.

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Claim 11: the first and second mounts are releasably coupled to one another by an upturned flange (3) on one mount and a downturned flange (3b) on the second mount.

Claims 16, 27 and 28: Han discloses a backsplash comprising a layer of protective material (5) having a front surface exposed to and resistant to byproducts. Han does not disclose first and second mounts as claimed. Breslow discloses a first mount mounted (either 10 or 11) to a first surface (7 or article to be attached, 12, which would be the backsplash) and a second mount (11 or 10) coupled to an article to be attached (or the first surface, which would draw the layer of protective material, the backsplash) to a flush position against the first surface, and the backsplash would be perpendicular to the work surface (Han: abstract, the counter). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mount with the panel system in Han because the mount would permit removal of the panel in Han for ease of replacement if damaged while also securing it properly to a surface.

Claim 17: the first and second mounts draw the layer of protective material to the first surface as the mounts are coupled together.

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Claim 18: a support (3) where the protective layer is attached.

Claim 19: a frame (1) to receive the support.

Claims 20 and 29: the protective material is tile (20).

Claim 21: the frame is shaped to receive the layer of protective material.

Claims 22 and 32: one mount has an upturned flange (3) that is engageable with a downturned flange (3b) of a second mount.

Claims 23 and 25: the first and second mounts are shaped to draw the backsplash to the first surface as the mounts are coupled together.

Claims 24 and 33: one mount has a projection (3b) that is releasably engageable within an aperture (between 2 and 3) in another of the mounts.

Claim 30: the tiles are resistant to fluid.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Breslow as applied to claim 27 above, and further in view of Dills (U.S. Patent No. 3,514,578).

Claim 31: the prior art of record discloses the claimed invention except for positioning the backsplash between the work surface and a range hood located above the work surface. Dills discloses a backsplash (Fig. 1: 19) located between a work

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surface (10) and a range hood (22). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because backsplashes are well known in the art for preventing damage to walls, and one of ordinary skill in the art would place the backsplash between a range and hood. This is also obvious because it is further well known in the art to have range hoods over ranges for ventilation.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG 10¹⁰ Oct 07

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10/10/07